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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,044	04/19/2000	Hans-Ulrich Buschhaus	Mo-5586-LeA 33,605	3337

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BAYER CHEMICALS CORPORATION
100 BAYER ROAD
PITTSBURGH, PA 15205

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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/552,044

Applicant(s)

BUSCHHAUS ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/03/03 & 04/30/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. *The following is a quotation of the second paragraph of 35 U.S.C. 112:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. *Claims 40-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The recited "acrylate dispersions" per claims 40, 43, 45 and 47 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope, i.e., it is not readily ascertainable if "acrylate monomer(s)", "acrylate resin(s)" or else are intended.

Claim Rejections - 35 USC § 103

3. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:*

1. *Determining the scope and contents of the prior art.*
2. *Ascertaining the differences between the prior art and the claims at issue.*
3. *Resolving the level of ordinary skill in the pertinent art.*
4. *Considering objective evidence present in the application indicating obviousness or nonobviousness.*

5. *This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

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6. *Claims 40-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eversole et al (U.S. 3,113,399) in combination with Heuer et al (U.S. 5,972,971).*

Eversole et al disclose and exemplify aqueous protective coatings for seeds, against fungi, disease and insects, wherein, said coating compositions are defined basically as containing a paint vehicle which includes acrylic resins, alkyd resins, in particular 23 % penta soya oil alkyd resin (BB-6-60), water, nutrients, fungicides, emulsifiers, etc. See, e.g., cols. 1 and 3. More specifically, Eversole et al exemplify aqueous seed coating compositions containing, basically, water, as a paint vehicle, maleic anhydride modified drying oil, Captan (fungicide) emulsifier (Triton X-100) and other conventional adjuncts. See Run II.

The disclosure of Eversole et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the specifically defined (A) components. Eversole et al, however, @ col. 3, lines 11-19 and Run II teach that fungicides such as captan (sulfenamide) may be added to the compositions to provide protection against fungi.

Heuer et al @ col. 4, lines 58-59 & col. 6, lines 7-11 teach that fungicidal compounds, viz., sulfenamides such as dichlorofluanid, tolylfluand, fluorofoipet and captan are well known equivalents for use against wood-destroying fungi. Therefore, it would have been obvious, on its face, to use sulfenamides such as dichlorofluanid, tolylfluand and/or fluorofoipet as the fungicide(s), taught as equivalents in scope for protection against fungi, in the compositions of Eversole et al and with a reasonable expectation of success. More specifically, it would have been obvious to the skilled artisan to swap the captan per Run II for any of the antecedently recited fungicides disclosed as operable equivalents per Heuer et al and with a reasonable expectation of success with the understanding that

one of ordinary skill in the art would have readily envisioned the use of the oil-modified alkyd resin used in Run VII in lieu of the maleic anhydride modified drying oil per Run II since they are taught as operable equivalents at col. 3, lines 24-42. It is the base presumption that the aforementioned alkyd resin may very well possess the claimed pH value since it is essentially the same as the claimed binder component and in the absence of the USPTO having at its disposal the tools deemed necessary to make physical determinations of this sort. Even if this turns out not to be the case, the use of any commercially available vegetable oil alkyd resin in lieu of the penta soya oil alkyd resin would have been obvious to the skilled artisan and with a

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reasonable expectation of success. Criticality for such, commensurate in scope with the claims, not having been demonstrated on this record.

As to the storage stability of the composition of Eversole et al, as modified, it would be expected that the composition of Eversole et al would be storage stable since the composition of Eversole et al, as modified, is essentially the same as the claimed composition.

The introductory phrases "A method for protecting" and "A method for stabilizing" per claims 43 and 45, respectively, do not serve to patentably distinguish the claim method from the system of Eversole et al. While Eversole et al may not show a specific recognition of these results, the discovery by applicant is tantamount only to finding a property of an old composition. Such recognition does not impart patentability to an otherwise old composition as provided for under the auspices of In re Tomlinson et al(150 USPQ 623).

Claim Rejections - 35 USC § 102

7. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. *Claims 40-47 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ludwig et al(U.S. 5,990,143).*

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Ludwig et al disclose water-based, solvent and emulsifier-free, microbial active compound-governed compositions for use in fields of application such as water-based wood preservatives. In particular, Ludwig et al disclose aqueous and optionally organic solvent- and emulsifier-free microbicidal active compound combinations comprising known azole fungicides and quaternary ammonium fungicides. Further, Ludwig et al @ col. 2, lines 12-16 disclose that one object of the invention is to provide, preferably, water-based, solvent- and emulsifier-free microbicidal active compound formulations based on azole fungicides, which can be diluted easily with water and then give storage-stable solutions for use. Ludwig et al @ col. 3, lines 26-48 teach that to prepare aqueous formulations, the active compounds are incorporated individually or as an active compound combination, for example in the form of powders, granules, pastes or concentrated solutions, suspensions or emulsions, into water by simple mixing, and are then present in the form of an aqueous suspension, solution or emulsion and that the aqueous solutions or emulsions preferably contain more than 20% by weight, in particular more than 40% by weight of water and can be diluted with water as desired to the use concentration. Ludwig et al further teach that the microbicidal agents contain the active compound combination in a concentration of 0.001 to 95% by weight, in particular 0.01 to 60% by weight, and in addition optionally 0.001 to 30% by weight, in particular 0.01 to 20% by weight, especially 0.05-10% by weight, of a suitable additional fungicide, insecticide or an additional active compound which includes sulphenamides such as dichlofluanid (Euparen), tolylfluanid(Yethyleuparen), folpet or fluorfolpet. Furthermore, Ludwig et al @ col. 4, lines 22-59 teach that the compositions my further contain binders such as acrylic resins, vegetable oil-containing alkyd resins(reasonably presumed to have a pH value falling within the scope of the claims since the resin are essentially the same as the claimed resins and in the absence of the USPTO to have at its disposal, the tools and facilities to make physical determinations of this sort, however, even if this turns out not to be the case, the use of any commercially available vegetable oil-containing alkyd resin in lieu of the vegetable oil-containing alkyd resin of Ludwig et al would have been prima facie obvious and with a reasonable expectation of success), etc. Ludwig et al therefore anticipate the instantly claimed invention with the understanding that "comprising" leaves the claims open for the inclusion of unspecified ingredients, even in major amounts(Ex parte Davis et al, 80 USPQ 448).

The introductory phrases "A method for protecting" and "A method for stabilizing" per claims 43 and 45, respectively, do not serve to patentably distinguish the claim method from the system of Ludwig et al. While Ludwig et al may not show a specific recognition of these results, the discovery by applicant is tantamount only to finding a property of an

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old composition. Such recognition does not impart patentability to an otherwise old composition as provided for under the auspices of In re Tomlinson et al(150 USPQ 623).

Response to Arguments

10. *Applicant's arguments filed 04/30/03 have been fully considered but they are not persuasive.*

Relative to Eversole et al—The crux of Counsel's arguments appear to hinge on the disclosure of Eversole et al does not render the presently claimed invention obvious, in view of the newly added claims. Further Counsel argues that the aqueous system per Run II is not storage stable. Firstly, it is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over Eversole et al as per reasons clearly set forth in the Grounds of Rejection supra. As to storage stability of the aqueous formulations of Eversole et al, as modified, mere counsel's arguments, unsupported by factual evidence, are given little weight(In re Lindner, 173 USPQ 356). There is absolutely nothing iron clad on this record diffusing this issue.

Relative to Ludwig et al —The crux of Counsel's arguments appears to hinge on the additional "azole" fungicides of Ludwig et al being precluded from the instantly claimed invention. Counsel is reminded that "comprising" is an open door invite to components, in addition to those as claimed. As to the storage stability, counsel is cordially directed to col. 2, lines 12+ wherein storage-stable solutions for use are taught as being one of the objectives of the disclosed invention.

Conclusion

11. *Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.*

Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
July 21, 2003